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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Kabushiki Kaisha NKB

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Serial No. 75/620,087

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Howard N. Aronson of Lackenbach Siegel for Kabushiki Kaisha NKB.

D. Beryl Gardner, Trademark Examining Attorney, Law Office 107 (Thomas Lamone, Managing Attorney).

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Before Hairston, Rogers and Bucher, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

An intent-to-use application has been filed by Kabushiki Kaisha NKB to register the mark PANDA NET ("NET" is disclaimed) for "entertainment services, namely, providing an on-line computer game for virtual play of the game 'Go'." [1]

Registration has been refused by the Trademark Examining Attorney pursuant to Section 2(d) of the

[1] Serial No. 75/620,087 filed January 13, 1999.

Trademark Act, 15 U.S.C. 1052(d), on the ground that the use of applicant's mark for the identified services would be likely to cause confusion with the registered mark PANDA BYTE ("BYTE" is disclaimed) for "computer game programs [and] game software."[2]

Applicant has appealed. This case has been fully briefed, but no oral hearing was requested. We affirm the refusal of registration.

Our determination is based on analysis of all of the probative facts in evidence that are relevant to the factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Turning first to the respective goods and services, it is well settled that in determining likelihood of confusion in a proceeding such as this, goods and/or services need not be identical or even competitive in order to find confusion likely. All that is necessary is that the goods

[2] Registration No. 2,245,132 issued May 11, 1999. Although the registration also covers audio and video storage materials, the refusal to register is based on a likelihood of confusion with the above specified goods.

and/or services be related in some manner or that the marketing conditions are such that they would be encountered by the same purchasers under circumstances that would give rise, because of the marks, to the mistaken belief that the goods and/or services originate or are somehow associated with the same source. Chemical New York Corp. v Conmar Form Systems, Inc., 1 USPQ2d 1139 (TTAB 1986).

Applicant argues that its services of providing an on-line computer game are dissimilar to the registrant's audio and video storage materials. However, it appears that applicant has completely overlooked the fact that the refusal to register is based, not on the audio and video storage materials in the cited registration, but rather on the computer game programs and game software. As the Examining Attorney points out, both applicant's services of providing an on-line game and registrant's computer game programs and game software are in the nature of games. Also, registrant's goods, as identified in the registration, are not restricted to particular games, and in the absence of such restrictions, we must presume that registrant's computer game programs and game software include those for playing the game "GO." We would add that the services of providing an on-line game and computer game

programs and game software are purchased or used by the same class of individuals, i.e., game players. Thus, we find that applicant's services and registrant's goods are sufficiently related, that if sold under the same or similar marks, purchasers or users are likely to be confused. We should note that, in support of her contention that the involved goods and services are related, the Examining Attorney made of record several third-party registrations. Two of the registrations are for marks which cover on-line games, on the one hand, and computer game software, on the other hand, and a third registration is for a mark which covers computer software for use in downloading an on-line game. Such registrations, although few in number, confirm our finding with respect to the relatedness of the goods and services.

Turning next to a consideration of the marks PANDA NET and PANDA BYTE, we find that when considered in their entireties, they are substantially similar in commercial impression. In considering the marks, we recognize that the disclaimed portion of each mark cannot be ignored. Giant Food, Inc. v. National Food Service, Inc., 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). However, there is nothing improper in giving more weight, for rational reasons, to a particular feature of a mark. Here, we have

given more weight to the PANDA portion of both applicant's and registrant's marks because of the descriptive nature of the remaining terms in the marks, i.e., NET and BYTE. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Not only are customers most likely to remember the PANDA portion of the marks, but they may not even notice that the marks differ in their ending portions, given that both BYTE and NET have computer connotations. In finding that the marks are substantially similar, we have kept in mind the normal fallibility of human memory over time and the fact that the average consumer retains a general, rather than a specific impression of trademarks encountered in the marketplace. In reaching our decision herein, we have not overlooked applicant's argument that marks containing the word PANDA are weak marks which are therefore entitled to a limited scope of protection. However, a close examination of the third-party registrations on which applicant bases its position reveals that they do not support such a conclusion. All of the third-party registrations are for goods which are very different from the goods and services at issue herein. For example, the mark PANDA is registered to one entity for electronic air purification equipment and to another entity for electronic signal processing circuits.

Finally, applicant argues that the Office has taken an "inconsistent" position with respect to this application vis-a-vis applicant's applications to register the marks PANDA EGG for "computer software for virtual play of the game "GO" via on-line communication computer network" and IGS-PANDA for "providing games via on-line communication computer network." According to applicant, neither of these applications has been refused registration based on the cited mark.

While uniform treatment under the Act is a goal, our task in this appeal is to determine, based on the record before us, whether there is a likelihood of confusion between applicant's mark and the cited mark. As often noted by the Board, we must decide each case on its own set of facts and record. See In re Consolidated Foods Corp., 200 USPQ 477 (TTAB 1978). In this case, the involved marks consist of the identical arbitrary word PANDA followed by a disclaimed term which connotes computers and the marks are or may be used for presumptively similar computer games.

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed.